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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/685,612	10/15/2003	Colin G. Harrison	YOR920030272US1	5096

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IBM CORPORATION, T.J. WATSON RESEARCH CENTER
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EXAMINER

VETTER, DANIEL

ART UNIT	PAPER NUMBER
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3628

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	04/02/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

10/685,612

Applicant(s)

HARRISON ET AL.

Examiner

Daniel P. Vetter

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-31 is/are pending in the application.
- 4a) Of the above claim(s) 16 is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-15 and 17-31 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 15 October 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date 2/8/2007.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: ____.

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DETAILED ACTION

Claims 1-31 are pending in this application.

Election/Restrictions

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1-15 and 17-31, drawn to a method and article of manufacture for validating a service consumer, classified in class 705, subclass 1.
 - II. Claim 16, drawn to a method of revalidating the ability of a consumer to carry out a consumer service process, classified in class 705, subclass 1.

The inventions are distinct, each from the other because of the following reasons:

2. Inventions I and II are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct if they do not overlap in scope and are not obvious variants, and if it is shown that at least one subcombination is separately usable. In the instant case, subcombination I has separate utility such as providing a service invocation specification. See MPEP § 806.05(d).

The examiner has required restriction between subcombinations usable together. Where applicant elects a subcombination and claims thereto are subsequently found allowable, any claim(s) depending from or otherwise requiring all the limitations of the allowable subcombination will be examined for patentability in accordance with 37 CFR 1.104. See MPEP § 821.04(a). Applicant is advised that if any claim presented in a

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continuation or divisional application is anticipated by, or includes all the limitations of, a claim that is allowable in the present application, such claim may be subject to provisional statutory and/or nonstatutory double patenting rejections over the claims of the instant application.

3. Because these inventions are independent or distinct for the reasons given above and there would be a serious burden on the examiner if restriction is not required because the inventions require a different field of search (see MPEP § 808.02), and the inventions have acquired a separate status in the art due to their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

4. During a telephone conversation with Mark Wardas on March 20, 2007 a provisional election was made with traverse to prosecute invention I, claims 1-15 and 17-31. Affirmation of this election must be made by applicant in replying to this Office action. Claim 16 is withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

5. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

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Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

7. Claims 1-3, 6-7, 10, 13-14, 17-19, 22-23, 26, and 29-30 are rejected under 35 U.S.C. 102(e) as being anticipated by Wisner, et al., U.S. Pat. No. 6,868,403 (Reference A of the attached PTO-892).

8. As per claims 1 and 17, Wisner, et al. teaches providing a service invocation specification (column 18, lines 45-50); providing to a Consumer first validation data related to a service (column 18, lines 54-57); receiving from the Consumer a set of second validation data responsive to said first validation data and complying with said service invocation specification (column 18, lines 58-63); and providing the service process responsive to evaluation of said set of second validation data for compliance with said service invocation specification (column 19, lines 31-34).

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9. As per claims 2 and 18, Wiser, et al. teaches the method and article of manufacture of claims 1 and 17 as described above. Wiser, et al. further teaches said second validation data include data elements that are not included within said first validation data and are generated by said Consumer in response to said first validation data (column 18, lines 58-63).

10. As per claims 3 and 19, Wiser, et al. teaches the method and article of manufacture of claims 1 and 17 as described above. Wiser, et al. further teaches analyzing compliance by said second validation data with said service invocation specification (column 18, lines 64-66).

11. As per claims 6 and 22, Wiser, et al. teaches the method and article of manufacture of claims 1 and 17 as described above. Wiser, et al. further teaches at least some of said first validation data are generated by a source other than said Provider (column 15, lines 19-20).

12. As per claims 7 and 23, Wiser, et al. teaches the method and article of manufacture of claims 1 and 17 as described above. Wiser, et al. further teaches said Provider performs validation without charge (column 3, line 61; column 14, line 47 - column 15, line 8).

13. As per claims 10 and 26, Wiser, et al. teaches the method and article of manufacture of claims 1 and 17 as described above. Wiser, et al. further teaches said

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Provider validates all second validation data submitted by a Consumer and thereby provides service to all Consumers that submit second validation data (column 3, lines 20-22; column 18, lines 64-66).

14. As per claims 13 and 29, Wiser, et al. teaches the method and article of manufacture of claims 1 and 17 as described above. Wiser, et al. further teaches the Provider notifies the Consumer that the step of providing the service is contingent on at least one of: amount of time elapsed since receipt of second validation data remaining below a threshold; reconfirmation after a scheduled time; and the service will only be provided along with other services (column 22, lines 4-17).

15. As per claims 14 and 30, Wiser, et al. teaches the method and article of manufacture of claims 1 and 17 as described above. Wiser, et al. further teaches Receiving a Consumer request for first validation data Responsive to said request (column 18, line 49), transmitting said first validation data to said service Consumer (column 18, lines 52-53).

Claim Rejections - 35 USC § 103

16. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

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invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

17. Claims 4, 15, 20, and 31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wiser, et al. in view of Official Notice.

18. As per claims 4 and 20, Wiser, et al. teaches the method and article of manufacture of claims 1 and 17 as described above. Wiser, et al. does not explicitly teach said step of analyzing compliance is performed by a third party that transmits the results thereof to the Provider. Official Notice is taken that it would have been prima facie obvious to one having ordinary skill in the art at the time of invention to incorporate said step of analyzing compliance is performed by a third party that transmits the results thereof to the Provider because it is old and well known to use third parties for verification to achieve a more reliable and impartial result.

19. As per claims 15 and 31, Wiser, et al. teaches the method and article of manufacture of claims 1 and 17 as described above. Wiser, et al. further teaches said service invocation specification comprises specifications for a delivered service (column 18, lines 47-49). Wiser, et al. does not explicitly teach which delivered service is supplied in part by at least one third-party Provider that supplies at least one service to said Provider that is included in the delivered service supplied to said Consumer. Official Notice is taken that it would have been prima facie obvious to one having

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ordinary skill in the art at the time of invention to incorporate said service invocation specification comprises specifications for a delivered service, which delivered service is supplied in part by at least one third-party Provider that supplies at least one service to said Provider that is included in the delivered service supplied to said Consumer into the teachings of Wisner, et al. because it is old and well known to use a third party to provide certain services for greater efficiency.

20. Claims 5 and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wisner, et al. in view of Stolfo, et al., U.S. Pat. Pub. No. 2001/0044785 (Reference B of the attached PTO-892).

21. As per claims 5 and 21, Wisner, et al. teaches the method and article of manufacture of claims 1 and 17 as described above. Wisner, et al. does not teach said first validation data include at least one error injected therein; and said second validation data include an indication of said injected errors. Stolfo, et al. teaches said first validation data include at least one error injected therein (§ 0061); and said second validation data include an indication of said injected errors (§ 0065). It would have been prima facie obvious to one having ordinary skill in the art at the time of invention to incorporate said first validation data include at least one error injected therein; and said second validation data include an indication of said injected errors into the teachings of Wisner, et al. for use in data encryption (as taught by Stolfo, et al., § 0061).

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22. Claims 8-9, 12, 24-25, and 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wiser, et al. in view of Tadano, et al., U.S. Pat. No. 2002/0165807 (Reference C of the attached PTO-892).

23. As per claims 8 and 24, Wiser, et al. teaches the method and article of manufacture of claims 1 and 17 as described above. Wiser, et al. does not teach said Provider charges said Consumer for services at a rate that depends on the result of said validation. Tadano, et al. teaches Provider charges said Consumer for services at a rate that depends on the result of said validation (§§ 0093-94). It would have been prima facie obvious to one having ordinary skill in the art at the time of invention to incorporate said Provider charges said Consumer for services at a rate that depends on the result of said validation into the teachings of Wiser, et al. in order to implement a result-dependent billing scheme (as taught by Tadano, et al., §§ 0093).

24. As per claims 9 and 25, Wiser, et al. in view of Tadano, et al. teaches the method and article of manufacture of claims 8 and 24 as described above. Tadano, et al. further teaches said Provider charges at a first rate for services for which the Consumer has qualified and at a second rate for services for which the Consumer has not qualified (§ 0097). It would have been prima facie obvious to one having ordinary skill in the art at the time of invention to incorporate said Provider charges at a first rate for services for which the Consumer has qualified and at a second rate for services for which the

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Consumer has not qualified into the teachings of Wiser, et al. in view of Tadano, et al. in order to provide discounts for approved users (as taught by Tadano, et al., ¶ 0097).

25. As per claims 12 and 28, Wiser, et al. in view of Tadano, et al. teaches the method and article of manufacture of claims 8 and 24 as described above. Tadano, et al. further teaches said Provider charges said Consumer for services at a rate that reflects an additional cost to said Provider for supplying services to a Consumer that has not met the provisions of said service invocation specification (¶ 0015). It would have been prima facie obvious to one having ordinary skill in the art at the time of invention to incorporate said Provider charges said Consumer for services at a rate that reflects an additional cost to said Provider for supplying services to a Consumer that has not met the provisions of said service invocation specification into the teachings of Wiser, et al. in view of Tadano, et al. in order to provide a discounted rate to previously registered customers (as taught by Tadano, et al., ¶ 0015).

26. Claims 11 and 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wiser, et al. in view of Jansen, et al., U.S. Pat. No. 6,243,450 (Reference D of the attached PTO-892).

27. As per claims 11 and 27, Wiser, et al. teaches the method and article of manufacture of claims 1 and 17 as described above. Wiser, et al. does not teach said Provider performs validation without charge below a service threshold and thereafter

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charges said Consumer for additional validation services. Jansen, et al. teaches said Provider performs validation without charge below a service threshold and thereafter charges said Consumer for additional validation services (column 12, lines 38-40). It would have been prima facie obvious to one having ordinary skill in the art at the time of invention to incorporate said Provider performs validation without charge below a service threshold and thereafter charges said Consumer for additional validation services into the teachings of Wiser, et al. to allow a grace amount threshold (as taught by Jansen, et al., column 12, line 38).

Conclusion

28. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Reed, et al., U.S. Pat. Pub. No. 2002/0095454 (Reference E of the PTO-892) teaches an automated communications system operates to transfer data, metadata and methods from a provider computer to a consumer computer through a communications network. Ferguson, et al., U.S. Pat. Pub. No. 2004/0078332 (Reference F of the attached PTO-892) teaches a system and method for purchasing pre-paid account cards and replenishing pre-paid accounts for goods and services.

29. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Daniel P. Vetter whose telephone number is (571) 270-

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1366. The examiner can normally be reached on Monday through Thursday from 8am to 6pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Hayes can be reached on (571) 272-6708. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


THOMAS J. HAYES
PATENT EXAMINER